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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,154	04/05/2001	Masaki Miyazaki	JP920000105US1	5118
23550 7590 04/09/2007 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/827,154

Applicant(s)

MIYAZAKI ET AL.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the RCE filed on December 21, 2006, which paper has been placed of record in the file.
2. Claims 1-19 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 7-12 and 17-19 have been considered but are not persuasive.

In response to applicant's argument that Korman does not disclose wherein the relay center updates counters provided therein based on said transaction request message or said transaction response message for a settlement among the plurality of financial institution systems, examiner submits that the host computer does not acts as a middle-man between a Super-ATM and a remote terminal, the host computer includes a workflow processor (equivalent to a counter) processes and keeps track of all of the received messages (column 10, lines 45-58) and processes settlement among the plurality of financial institution systems (column 11, lines 7-35, the workflow processor initiates a balance authorization of payment is being made using a card, carries out the transaction event if payment was made in cash; column 9, lines 50-55, the host computer monitors the individual Super-ATMs, the Super-ATM transmits data regarding amount of coins stored, amount of currency received). Therefore, Korman does disclose a relay center including a counter for settlement among the plurality of financial institution systems.

4. Applicant's arguments with respect to claims 1-6 and 13-16 have been considered but are moot in view of new ground of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 7-10 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Korman et al, (hereinafter Korman), U.S. Patent No. 6,308,887.

Regarding to claim 7, Korman discloses a system of using an automated teller machine, comprising:

an automated teller machine for identifying a financial institution based on an account identifying medium to conduct a financial transaction with a customer (figure 3, Super-ATM 10);

a plurality of financial institution systems for conducting transactions with said automated teller machine (figure 3, remote terminal 60); and

a relay center for relaying transactions between said automated teller machine and said financial institution systems (figure 3, host computer 40);

wherein said relay center transmits a transaction request message from said automated teller machine to one of the financial institution systems identified by said automated teller machine without passing through another financial institution system, and wherein said relay center transmits a transaction response message transmitted from said identified financial institution system to said automated teller machine (column 9, lines 35-38 and figure 3, Super-ATM transmits the information to the host computer 40, the host computer 40 then transmits to the appropriate remote terminal 60; column 9, lines 38-42, the host computer 40 receives the data back from the remote terminal and relays back to the appropriate Super ATM), and wherein said relay center includes a counter provided for each financial institution for a settlement among the plurality of financial institution systems (the host computer includes a workflow processor (equivalent to a counter) processes and keeps track of all of the received messages (column 10, lines 45-58) and processes settlement among the plurality of financial institution systems (column 11, lines 7-35, the workflow processor initiates a balance authorization of payment is being made using a card, carries out the transaction event if payment was made in cash; column 9, lines 50-55, the host computer monitors the individual Super-ATMs, the Super-ATM transmits data regarding amount of coins stored, amount of currency received).

Regarding to claim 8, Korman further discloses wherein said identified financial institution system updates counters provided therein based on said transaction request message or said transaction response message, and wherein said relay center updates counters provided therein based on said transaction request message or said

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transaction response message (column 10, lines 45-58, the message engine processes and keeps track of all of the received messages).

Regarding to claim 9, Korman further wherein said relay center defines a settlement amount after exchanging information of the counters provided in said identified financial institution systems and the counters provided in said relay center (column 11, lines 18-35).

Regarding to claim 10, Korman further discloses wherein said automated teller machine is managed by a particular financial institution, wherein a settlement with said relay center is performed by said particular financial institution or a selected financial institution other than said particular financial institution, and wherein if a settlement is performed by said selected financial institution, said selected financial institution performs a settlement with another financial institution (column 9, lines 40-50).

Claims 17-19 are written in means that contain similar limitations found in claims 7-10 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korman et al, (hereinafter Korman), U.S. Patent No. 6,308,887.

Regarding to claim 1, Korman discloses a method of handling a financial transaction using an automated teller machine that accepts an account identifying medium for identifying an account at one of a plurality of financial institutions, said medium being provided by said one of a plurality of financial institutions, comprising the steps of:

identifying an associated financial institution, with which a transaction is to be conducted, based on said account identifying medium inserted into said automated teller machine (column 2, lines 50-65, the user can use various payment means at Super-ATM, e.g. credit card, debit card, smart card, etc.);

creating an associate transaction request message based on information of said identified associated financial institution (column 9, lines 33-35, Super-ATM prompts the user for information on the desired transaction);

transmitting said created associate transaction request message to a computer system of said associated financial institution through a relay center, without passing through a computer system of another financial institution (column 9, lines 35-38 and figure 3, Super-ATM transmits the information to the host computer 40, the host computer 40 then transmits to the appropriate remote terminal 60); and

receiving an associate transaction response message corresponding to said transaction request message from the computer system of said associated financial institution through said relay center (column 9, lines 38-42, the host computer 40 receives the data back from the remote terminal and relays back to the appropriate Super ATM).

Korman does not disclose displaying a screen menu created by the associated financial institution. However, Korman discloses the Super-ATM communicates with a variety of service providers in the protocols and message formats of the service providers, the Super-ATM, in response to a user input, executes the transactions with several service providers by sending messages to the service providers in their respective message formats (see column 1, line 65-column 2, line 12). The Super-ATM allows the user to conduct financial transaction with a plurality of service providers, e.g. buying movie tickets, airline tickets, etc...(see column 7, line 55-column 8, line 12). Moreover, displaying a screen menu created by the associated financial institution is well known in the art. For example, the airline reservation system or a movie ticket system provides a screen menu to the user easily to select desired products for purchasing. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to include incorporate the well-known feature above for the purpose of providing more convenient and easier to the user to select a desired product for purchasing at a service provider.

Regarding to claim 2, Korman further discloses wherein a counter provided at said relay center for each associated financial institution is updated based on said transaction request message or said transaction response message (column 10, lines 45-58, the message engine processes and keeps track of all of the received messages).

Regarding to claim 3, Korman further discloses wherein said automated teller machine is managed by a particular financial institution, further comprising the steps of:
identifying a non-associated financial institution, with which a transaction is to be

conducted, based on said account identifying medium inserted into said automated teller machine (column 2, lines 50-65, the user can use various payment means at Super-ATM, e.g. credit card, debit card, smart card, etc.);

creating a non-associate transaction request message based on information of said identified non-associated financial institution (column 9, lines 25-32 and figure 3, e.g. credit card processing network 430 is utilized to verify and process credit card transactions);

transmitting said created non-associate transaction request message to a computer system of said non-associated financial institution through said relay center (column 9, lines 35-38 and figure 3, Super-ATM transmits the information to the host computer 40, the host computer 40 then transmits to the appropriate remote terminal 60); and

conducting a transaction with said non-associated financial institution through the computer system of said particular financial institution (column 9, lines 40-50).

Regarding to claim 4, Korman discloses a method of displaying financial transaction menu screens on a display of an automated teller machine that is managed by a predetermined managing financial institution, comprising the steps of:

accepting a medium that has identification information for identifying an account at one of a plurality of financial institutions (column 2, lines 50-65, the user can use various payment means at Super-ATM, e.g. credit card, debit card, smart card, etc.);

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identifying a financial institution based on said accepted medium (column 14, lines 58-65, selecting at the transaction terminal a service offered by one of the service providers in response to the request if the identification information is confirmed); and

Korman does not disclose if said identified financial institution is not said managing financial institution, displaying a financial transaction menu screen unique to said identified financial institution on said display in place of a menu screen created by said managing financial institution. However, Korman discloses the Super-ATM communicates with a variety of service providers in the protocols and message formats of the service providers, the Super-ATM, in response to a user input, executes the transactions with several service providers by sending messages to the service providers in their respective message formats (see column 1, line 65-column 2, line 12). The Super-ATM allows the user to conduct financial transaction with a plurality of service providers, e.g. buying movie tickets, airline tickets, etc...(see column 7, line 55-column 8, line 12). Moreover, displaying a screen menu created by the associated financial institution is well known in the art. For example, the airline reservation system or a movie ticket system provides a screen menu to the user easily to select desired products for purchasing. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to include incorporate the well-known feature above for the purpose of providing more convenient and easier to the user to select a desired product for purchasing at a service provider.

Regarding to claim 5, Korman further discloses wherein after said financial institution is identified, a menu screen previously stored in said automated teller

machine is displayed on said display as an initial transaction menu, and one or more succeeding menu screens received from a remote location are displayed on said display (column 7, lines 55-67).

Regarding to claim 6, Korman discloses a method of displaying menu screens for use in financial transactions with an associated financial institution and a non-associated financial institution on a display of an automated teller machine that is managed by a managing financial institution, comprising the steps of:

if a card for said associated financial institution is accepted, identifying said associated financial institution based on said card and displaying a menu screen unique to said identified financial institution on said display (column 4, lines 50-65, Super-ATM displays messages and user menus included transitional choices and non-traditional choices); and

Korman does not disclose if a card for said non-associated financial institution is accepted, displaying a menu screen for a non-associated financial institution created by said managing financial institution on said display. However, Korman discloses the Super-ATM communicates with a variety of service providers in the protocols and message formats of the service providers, the Super-ATM, in response to a user input, executes the transactions with several service providers by sending messages to the service providers in their respective message formats (see column 1, line 65-column 2, line 12). The Super-ATM allows the user to conduct financial transaction with a plurality of service providers, e.g. buying movie tickets, airline tickets, etc...(see column 7, line 55-column 8, line 12). Moreover, displaying a screen menu created by the associated

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financial institution is well known in the art. For example, the airline reservation system or a movie ticket system provides a screen menu to the user easily to select desired products for purchasing. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to include incorporate the well-known feature above for the purpose of providing more convenient and easier to the user to select a desired product for purchasing at a service provider.

Regarding to claim 11, Korman discloses a system of using an automated teller machine, comprising:

- an automated teller machine for identifying a financial institution based on an account identifying medium to conduct a financial transaction with a customer (figure 3, Super-ATM 10);

- a plurality of financial institution systems for conducting transactions with said automated teller machine (figure 3, remoter terminal 60); and

- a relay center for relaying transactions between said automated teller machine and said financial institution systems (figure 3, host computer 40);

wherein said automated teller machine enciphers a personal identification number inputted by said customer and transmits the enciphered personal identification number to said relay center for use in the identified financial institution, wherein said relay center transmits the enciphered personal identification number to the identified financial institution system (column 5, lines 15-30, the keypad is an encryption PIN pad, the keys are depressed at the PIN pad and are encrypted into messages; column 9, lines 35-38 and figure 3, Super-ATM transmits messages to the host computer 40, the host

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computer 40 then transmits to the appropriate remote terminal 60, it is inherited that the host computer transmits the encrypted PIN to the appropriate remote terminal because the encrypted PIN contained in the messages), and said relay center includes a counter provided for each financial institution for a settlement among the plurality of financial institution systems (the host computer includes a workflow processor (equivalent to a counter) processes and keeps track of all of the received messages (column 10, lines 45-58) and processes settlement among the plurality of financial institution systems (column 11, lines 7-35, the workflow processor initiates a balance authorization of payment is being made using a card, carries out the transaction event if payment was made in cash; column 9, lines 50-55, the host computer monitors the individual Super-ATMs, the Super-ATM transmits data regarding amount of coins stored, amount of currency received).

Korman does not disclose wherein said identified financial institution system deciphers said enciphered personal identification number. However, decrypting the encrypted PIN is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to include the feature above for the purpose of decrypting the PIN at the remote terminal in order to recognize the PIN for verifying the user information before authorizing the transaction.

Regarding to claim 12, Korman does not disclose wherein said financial institution system has a private key and a public key, wherein said automated teller machine receives said public key from said financial institution system through said relay center,

and enciphers said personal identification number using a public key which is different for each financial institution, and wherein said financial institution system uses the private key for deciphering said personal identification number enciphered by said public key. However, encrypting/decrypting technique using public/private keys is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to adopt the well known features above for the purpose of enhancing the security in processing financial transaction at the ATM.

Claims 13-15 are written in means that contain similar limitations found in claims 1-6 above, therefore, are rejected by the same rationale.

Conclusion

9. Claims **1-19** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571) 272-6777.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).



NGA NGUYEN
PRIMARY EXAMINER

March 30, 2007